

In re Appln of Ayala BARAK
Application No. 10/586,349
Reply dated January 25, 2012
Response to Office Action mailed October 25, 2011

REMARKS

The Official Action mailed October 25, 2011, and the prior art relied upon therein have been carefully studied. The claims in the application are now claims 95, 99-103, 106-119, 122-125, and 127-137, and Applicant believes and respectfully submits that these claims are patentable for the reasons given below. The present reply is intended to be fully responsive to all points raised in the Office Action, and is believed to place the present application in condition for allowance. Favorable consideration and allowance are respectfully requested.

Claims 95, 126,129 and 130 are amended above, and claims 97 and 105 have been cancelled. The main feature added to the independent claims is a recitation that the biocide is substantially free of any other essential compound, i.e. if any other essential compound is present, it would only be present in a way which is not meaningful, e.g. in a trace amount. This excludes the presence of the critical anionic polymer and phosphonic acid compound which are required according to the Tsuneki referece. The recitation is supported by the examples.

The Examiner states in the Office Action that claims 95, 97, 99 – 103, 105 – 108, 111, 122 – 124 and 129, 132 and 134 – 137 are not entitled to claim benefit from provisional applications U.S.S.N. 60/536,811, U.S.S.N. 60/536,851, U.S.S.N. 60/536,852 and U.S.S.N. 60/536,853, all filed January 14, 2004, since the genus of nitrogen-containing compounds recited in these claims is not fully supported by the priority applications. In the present reply, the nitrogen-containing compound recited in claims 95, 125 and 129 is limited to ammonium carbamate and ammonium sulfamate. Both of these compounds are described in the provisional applications (see, for example, U.S.S.N. 60/536,811 pages 15 – 17 [Example 13]). Applicant maintains, therefore, that all of the claims are entitled to the claimed benefit date of January 14, 2004.

Claims 95, 97, 102, 103, 105, 122, 124, 132 and 134 - 137 stand rejected under 35 U.S.C. 102(b) as being anticipated by Tsuneki (WO 03/96810, corresponding to U.S. Patent Application Publication No. 2006/0054563). This rejection is respectfully traversed.

As stated in the Office Action, Tsuneki discloses a composition comprising, *inter alia*, a compound selected from an anionic polymer and a phosphonic acid compound, wherein the composition has a pH of 12 or greater. Claim 95 recites that the pH of the biocide is between

In re Appln of Ayala BARAK
Application No. 10/586,349
Reply dated January 25, 2012
Response to Office Action mailed October 25, 2011

9.0 and 11.5. Furthermore, claim 95 is presently amended to recite that the biocide is free of any meaningful or substantial quantity of any other essential ingredient, it being known that Tsuneki requires the presence of an anionic polymer or a phosphonic acid compound as an essential ingredient (see, for example, paragraph [0009]).

Tsuneki does not disclose a biocide having a pH between 9.0 and 11.5, nor does Tsuneki disclose a biocide free of other essential components, i.e. in the case of Tsuneki free of the anionic polymer and/or the phosphonic acid compound which are required by Tsuneki.

Accordingly, none of Applicants' claims are anticipated by Tsuneki and the rejection should be withdrawn. Such is respectfully requested.

Claims 95, 97, 102, 103, 105, 122, 124, 132 and 134 - 137 stand rejected under 35 U.S.C. §102(e) as being anticipated by Tsuneki (U.S. Patent Application Publication No. 2006/0054563). This rejection is respectfully traversed.

Applicant maintains that Tsuneki has no §102(e) date since Tsuneki is based on an international application published in a language other than English. Furthermore, Applicant maintains that Tsuneki does not anticipate the presently claimed invention for the reasons stated above.

Withdrawal of this rejection is in order and is respectfully requested.

Claims 95, 97, 99, 102, 103, 105, 108, 111, 122 – 124, 129, 132, 134 and 135 stand rejected under 35 U.S.C. §102(e) as being anticipated by Shim (WO 2005/19117). This rejection is respectfully traversed.

Applicant maintains that the §102(e) date of Shim is August 11, 2004, later than the priority date of the present invention January 14, 2004. Shim is the publication of International Application No. PCT/US2004/026044, filed August 11, 2004. Shim claims priority from a foreign application filed August 14, 2003 whose country of origin is not indicated in the PAIR system and whose application number is 2003-56571. The priority application of Shim is not a U.S. application, and therefore the 102(e) date of Shim is August 11, 2004. Accordingly, Shim is not available to be cited against the present application.

Withdrawal of the rejection is in order and is respectfully requested.

In re Appln of Ayala BARAK
Application No. 10/586,349
Reply dated January 25, 2012
Response to Office Action mailed October 25, 2011

Claims 95, 97, 99 – 103, 105 – 108, 111, 122 – 124, 129, 130, 132 and 134 - 137 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tsuneki in view of Barak (U.S. Patent No. 5,976,386 or U.S. Patent No. 6,132,628). Applicant notes that Barak '628 is a direct continuation of Barak '386 and that the specifications of Barak '628 and Barak '386 are identical. In view of the foregoing, arguments presented to overcome rejections based on Barak '386 also apply to rejections based on Barak '628. This rejection is respectfully traversed.

As stated in the Office Action, Tsuneki discloses a composition comprising a chlorine-based oxidizing agent, a sulfamic acid compound, a compound selected from an anionic polymer and a phosphonic acid compound, wherein the composition has a pH of 12 or greater. Claim 95 recites that the pH of the biocide is between 9.0 and 11.5. Furthermore, claim 95 is presently amended to recite that the biocide does not contain another essential compound, in this case a compound selected from an anionic polymer and a phosphonic acid compound.

Tsuneki discloses at paragraph [0081] that the compositions described therein were very unstable at pH 11 and that excellent stability can be obtained at pH greater than 12. There is nothing in Barak that would motivate a person of skill in the art to change the pH of the composition disclosed in Tsuneki from greater than 12 to between 9.0 and 11.5 as recited in present claims 95 and 129.

Furthermore, there is nothing in Barak that would motivate a person of skill in the art to change the composition disclosed in Tsuneki by removing the compound selected from an anionic polymer and a phosphonic acid compound. Accordingly, claims 95 and 129, which recite a biocide having a pH between 9.0 and 11.5 wherein the biocide does not contain another essential compound, i.e. a compound selected from an anionic polymer and a phosphonic acid compound, are patentable over Tsuneki in view of Barak. Claims 99 – 103, 106 – 108, 111, 122 – 124, 130, 132 and 134 – 137 all depend directly or ultimately from claim 95. Therefore, these claims are also patentable over Tsuneki in view of Barak.

Withdrawal of this rejection is in order and is respectfully requested.

Claims 95, 97, 99 – 103, 105 – 108, 111, 122 – 124, 129, 130, 132 and 134 - 137 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shim in view of Barak. This rejection is respectfully traversed.

As noted above, Shim is not available to be cited against the present application.

In re Appln of Ayala BARAK
Application No. 10/586,349
Reply dated January 25, 2012
Response to Office Action mailed October 25, 2011

Barak does not disclose a biocide containing ammonium carbamate or ammonium sulfamate, as recited in claims 95 and 129. Claims 99 – 103, 106 – 108, 111, 122 – 124, 130, 132 and 134 – 137 all depend directly or ultimately from claim 95. Therefore, all of the claims are patentable over Barak.

Withdrawal of the rejection is in order and is respectfully requested.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of Applicant's claims.

Applicant believes that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable reconsideration and allowance are respectfully requested.

If the Examiner has any questions or suggestions, the Examiner is respectfully invited and requested to contact the undersigned at (202) 628-5197.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By 
Sheridan Neimark
Registration No. 20,520

SN:ltm
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\CL\colb\Barak7\Pto\2012-01-25REPLY.doc